



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,525	10/11/2005	Katsu Kondo	KPO-SUN-P4/SN-89/US	4420
44702 7590 09/25/2008 OSTRAGER CHONG FLAHERTY & BROITMAN PC 570 LEXINGTON AVENUE FLOOR 17 NEW YORK, NY 10022-6894			EXAMINER STULII, VERA	
			ART UNIT 1794	PAPER NUMBER
			MAIL DATE 09/25/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/552,525	Applicant(s) KONDO ET AL.	
	Examiner VERA STULII	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-30 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 16-30 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/27/06, 08/13/06</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Objections

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Claim Rejections - 35 USC § 112 and § 101

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 16-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 16-29 provides for the use of malt sprouts, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 16-29 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under

Art Unit: 1794

35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

To expedite prosecution, claims would be construed as reciting a method of producing a food or alternatively a beverage product comprising the step of adding malt sprouts to the food or beverage product.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 16-17 and 21-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamamoto (JP 09-084540).

In regard to claim 16, Yamamoto discloses a process for producing food products, using malt sprouts of a controlled particle size (Abstract).

In regard to claim 17, Yamamoto discloses the process for producing food products, wherein the malt sprouts of controlled particle size are crushed at a low degree of crushing (Abstract, p. 3 Examples 1,2).

In regard to claim 21, which recites particle size smaller than 150µm, Yamamoto discloses that particles are finely crushed by a crusher having 50-200 µm clearance (Abstract).

In regard to claims 22 and 23, Yamamoto does not specifically state the surface area and bulk density of the malt sprouts particles. However, since Yamamoto discloses malt sprouts particles of the size as recited, the particular surface area and bulk density of the malt particles is seen to be inherent result characteristics of crushing malt sprouts, and will depend on a particular particle size lacking any clear and convincing evidence and/or arguments to the contrary.

In regard to claim 25, it is noted that the recitation of the phrase “wherein the beverage product is an alcoholic beverage or a non-alcoholic beverage” only further characterizes the type of beverage product in the alternatively recited products of the preamble, and thus the claim is still anticipated by Yamamoto. Since claim 25 recites production of the food product, Yamamoto meets limitation of claim 25.

In regard to claim 26, it is noted that recitation of the phrase “wherein the alcoholic beverage is beer, happoshu (low-malt beer beverage), liquor, low-alcohol malt beverage, liqueur, whiskey or shochu” only further characterizes the type of beverage product in the alternatively recited products of the preamble, and thus the claim is still anticipated by Yamamoto. Since claims 26 recites production of the food product, Yamamoto meets limitation of claim 26.

In regard to claim 27, which recites amount of malt sprouts used in the food product, Yamamoto discloses 18.3% of crushed malt sprouts in the food product (p. 4 [0014]).

In regard to claim 28, it is noted that recitation of the phrase “wherein the alcoholic beverage is beer, happoshu or low-alcohol malt beverage” only further

Art Unit: 1794

characterizes the type of beverage product in the alternatively recited products of the preamble, and thus the claim is still anticipated by Yamamoto. Since claim 28 recites production of the food product, Yamamoto meets limitation of claim 28.

In regard to claim 29, it is noted that recitation of the phrase “wherein the non-alcoholic beverage is a soft drink, a tea beverage or a milk beverage” only further characterizes the type of non-alcoholic beverage product in the alternatively recited products of the preamble, and thus the claim is still anticipated by Yamamoto. Since claims 29 recites production of the food product, Yamamoto meets limitation of claim 29.

Claims 16-20, 24-26 and 28-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Todorova et al.

In regard to claims 16-20, Todorova et al disclose a process for producing beverage products, using uncrushed malt sprouts (Abstract, p. 17). Since applicant discloses that the malt sprouts can be crushed or uncrushed and meets applicant’s definition of having controlled particle size, then Todorova’s uncrushed malt sprouts would also inherently read on a “controlled particle size”.

In regard to claims 18-19, Todorova et al disclose a process for producing beverage product comprising the further step of immersing the malt sprouts in a liquid to allow components of the malt sprouts to seep out into the liquid and further removing the malt sprouts after the immersion step during the waters soluble extract preparation (p.17). In regard to claim 20, Todorova et al discloses the use of malt sprouts extract in

Art Unit: 1794

beer production as a partial substitute for malt extract in beer wort production because of the nutrient value of malt sprouts and to more efficiently make use of a product (Abstract). Todorova would not employ the extract if it imparted an unpleasant flavor to the beer.

In regard to claims 24-26 and 28-29, Todorova et al discloses production of beer beverage. Further in regard to claims 24-26 and 28-29, Todorova is applied fro the same reasons as Yamamoto is employed, see the comments made in the rejection above, employing Yamamoto.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto (JP 09-084540) in view of Todorova et al.

The details of Yamamoto and Todorova et al. are discussed above. Yamamoto does not disclosed particular method steps as recited in claims 17-20. Yamamoto disclose directly adding crushed malt sprouts to a food product. Todorova discloses the fact that malt sprouts extract has very high nutritional value and is reach in amino acids, metal ions, phosphorus and vitamin B₁. Therefor, to modify Yamamoto and to substitute the particular form of the malt sprouts material used for its nutritional value would have been obvious.

Claims 21-23 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Todorova et al. in view of Yamamoto (JP 09-084540).

In regard to claim 21, which recites particle size smaller than 150µm, Todorova et al is silent as to the grinding step. Todorova et al disclose employing the whole malt sprouts. As evidenced by Yamamoto, it was well established to employ malt sprouts in the process of addition to a food product, wherein the malt sprouts are crushed or ground to a particular size within the recited limits. To modify Todorova and to employ ground malt sprouts of Yamamoto in the similar process would have been an obvious matter of choice.

In regard to claims 22 and 23, Todorova et al does not specifically state the surface area and bulk density of the malt sprouts particles. As stated immediately above, to modify Todorova and to employ ground malt sprouts of Yamamoto in the similar process would have been an obvious matter of choice. Since Yamamoto discloses malt sprouts particles of the size as recited, the particular surface area and

Art Unit: 1794

bulk density of the malt particles is seen to be inherent result characteristics of crushing malt sprouts, and will depend on a particular particle size lacking any clear and convincing evidence and/or arguments to the contrary.

In regard to claim 27, Todorova et al does not specifically disclose the amount of malt sprouts used. However, the amount of malt sprouts used is a result effective, routinely determinable variable. Therefore, to vary amounts of malt sprouts depending on the desired nutritional and organoleptical profile of the final product would have been obvious.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Danisova et al (CS8603712) disclose a baking product with addition of light malt bloom.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VERA STULII whose telephone number is (571)272-3221. The examiner can normally be reached on 7:00 am-3:30 pm, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1794

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Steve Weinstein/
Primary Examiner, Art Unit 1794

VS